



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,120	09/11/2006	Frank Henglein	P746-4	7418
2352 7590 02/19/2010 OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403				
EXAMINER				
PARVINI, PEGAH				
ART UNIT		PAPER NUMBER		
1793				
MAIL DATE		DELIVERY MODE		
02/19/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,120

Applicant(s)

HENGLEIN ET AL.

Examiner

PEGAH PARVINI

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15, 17-36 and 39-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15, 17-36 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is in reply to the Non-Final Rejection mailed on 7/7/2009. After entry of this amendment, claims 1-12, 15, 17-36, and 39-44 are currently pending in this Application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12, 15, 17-27, and 42-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 has been amended to recite that at least one metal chalcogenide layer being a "layer of an intrinsically" colored metal chalcogenide; however, it is not clear as what the applicants are attempting to convey by *intrinsically* colored. Intrinsic also means inherently; therefore, the examiner has interpreted the claim to mean inherently specially since the specification does not provide any definition otherwise.

Claims 2-12, 15, 17-27 and 42-43 are rejected as being dependent upon a rejection claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The rejection of **claims 1-12, 15, 17, 19-36 and 39-43**, over the combination of Reisser in view of Schmid et al. (i.e. U.S. Pat. No. 5,624,486) as evidenced by Andes et al. as generally set forth in the previous Office action is proper and stands.

With reference to the new limitation drawn to the at least one metal chalcogenide layer being a layer of an intrinsically colored metal chalcogenide, it is to be noted that it is the examiner's position that "intrinsically" mean that the metal chalcogenide layer is *inherently* colored. With that said, every metal chalcogenide has a color; thus, said limitation is met. It is to be noted that Reisser teaches oxidized aluminum or aluminum alloy pigments having a content of metallic aluminum of not more than 90% by weight, and in which Reisser further, disclose that it is possible to color aluminum pigments.

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Reisser in view of Schmid et al. as that evidenced by Andes et al.

As detailed out in the previous Office action and specifically page 5 of the previous Office action, Reisser discloses that the amount of water is from 10-120% by weight, and preferably from 15-55% by weight (column 4, lines 45-46).

The rejection of **claim 18**, over the combination of Reisser in view of Schmid et al. as evidenced by Andes et al. and further in view of Schmid et al. (i.e. U.S. Pat. No. 5,763,086) to as generally set forth in the previous Office action is proper and stands.

Response to Arguments

Applicants' arguments filed October 14, 2009 have been fully considered but they are not persuasive.

Applicants have argued that the combination of references does not disclose an intrinsically colored metal chalcogenide and a pigment capable of generating a color flop.

The Examiner, respectfully, submits that as pointed out above, intrinsically colored means inherently colored specially in view of no further explanation provided by Applicants in the specification as to what intrinsically colored metal chalcogenide may mean, and thus, has been treated accordingly. Namely, with reference to the new limitation drawn to the at least one metal chalcogenide layer being a layer of an intrinsically colored metal chalcogenide, it is to be noted that it is the examiner's position that "intrinsically" mean that the metal chalcogenide layer is *inherently* colored. With that said, every metal chalcogenide has a color; thus, said limitation is met. It is to be noted that Reisser teaches oxidized aluminum or aluminum alloy pigments having a content of metallic aluminum of not more than 90% by weight, and in which Reisser further, disclose that it is possible to color aluminum pigments.

Furthermore, since the reference teaches (see the previous Non-Final Rejection) most of the limitations of instant claims including claim 1; therefore, since the enveloping aluminum oxide-containing or aluminum oxide/hydroxide-containing layer is produced through an identical process according to the reference (i.e. Reisser) as that claimed instantly, it is expected from the reference to produce the same product having the same characteristics. Thus, the enveloping aluminum oxide-containing or aluminum oxide/hydroxide-containing layer is expected to have the same color flop as claimed instantly and burden is upon applicants to clearly shown evidence otherwise.

It should be noted that Reisser is the same EP 0 848 735 patent which Applicants have admitted in the instant Application specification (i.e. pages 14-15 and 17) that their pigments have been made according to said EP patent.

Applicants have submitted a declaration and pointed that said declaration has overcome the Schmid et al. reference with reference to wet-chemical process.

The declaration filed in October 14, 2009 has been considered and acknowledged; however, it does not overcome the rejection of instant claims as follows.

The Examiner, respectfully, submits that **(1)** wet-chemical process is a process limitation in the product claims; therefore, it adds no patentable weight to the examination of the product claim unless it imparts structural difference, and Applicants have not shown such. **(2)** The primary reference used instantly and in the previous Office action is Reisser which is the same EP 0 848 735 which applicants had used to make their own inventive pigments as admitted in the specification. Therefore, even

overcoming Schmid et al. wouldn't overcome the Reisser not only based on the above, but also because Schmid et al. was not relied on to address wet-chemical process. Again, even if so, wet-chemical process is a process limitation in a product claim.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGAH PARVINI whose telephone number is (571)272-2639. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegah Parvini/
Examiner, Art Unit 1793

/Anthony J Green/
Primary Examiner, Art Unit 1793